

REMARKS

Applicant thanks Examiner Araj for allowing claims 10-14 and indicating the allowability of dependent claims 34, 37 and 39. Further consideration of this application is respectfully requested in light of the amendments proposed above and the following remarks.

Removal of Finality

Initially, the Examiner is requested to remove the finality of the present action because it does not specifically address original claim 18. As noted above, claims 10-14, 34, 37 and 39 are indicated allowed or allowable. Claims 1-9, 15-17, 19-33, 35-36, and 38 are discussed in the Office Action, but claim 18 is not. Since no ground is asserted for the rejection of claim 18, it is respectfully requested that a new non-final action issue indicating its allowability, or presenting grounds for its rejection if the Examiner believes it is warranted.

Claim Objection

Claim 20 was objected to as possibly missing the word "a" in line 2. The Examiner is correct, and claim 20 has been amended accordingly. No change to the scope of claim 20 is intended or being made due to that amendment, and no new matter is being added.

Rejections under Section 112

The Office Action suggested that claims 20 and 21 did not comply with the written description requirement of section 112. As used in those claims, "second channel" refers to the channel recited in claim 15 via which the recited body is placed over the recited elongated member. Figures 1-3 show an embodiment of a body in which an aperture 24 is threaded and intersects the channel by which the body is placed over an elongated member. Among other

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text, paragraph 0016 describes an embodiment of aperture 24 that is threaded to accommodate a locking member 17, and that connects to channel 22 of body 12. Because both the text and the drawings provide a sufficient description for the relationship between aperture 24 and channel 22, the rejection under section 112 of claims 20 and 21 should be withdrawn.

Rejections under Section 102

The Office Action rejected only claims 15-17 and 19 over the previously-cited Brace reference (US 6,187,005). Respectfully, the Brace reference does not show all elements of any of those claims, and therefore withdrawal of this rejection is requested.

Independent claim 15 recites a method that includes providing a body and sliding a washer and an offsetting member over said body. The Office Action asserts that the nut 106 shown in Brace is a "washer." Respectfully, washers and nuts are distinct structures with different features and functions, and it cannot be said that a nut is a washer. Moreover, neither the nut 106 nor the ball clamp 100 of Brace "slide" over a body. The nature of a nut is to thread onto Brace's screw, and its threads prevent it from sliding over anything. Ball clamp 100 is around the screw and appears to pivot inside, not over, item 90 of Brace. Thus, not only does Brace lack a "washer," as discussed above, but the nut and ball clamp do not, and cannot, slide over a body as recited in claim 15.

The Brace reference also does not show an offsetting member that engages a fastener in at least two locations, as claim 15 recites. The Office Action proposes that ball clamp 100 of Brace is an "offsetting member," but ball clamp 100 engages screw 94 at one location, the conical surface 96.

For at least these reasons, Brace cannot anticipate claim 15. Claims 16-17 and 19 are allowable at least due to their dependence from claim 15.

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Claims 22-24, 26-33 and 38 were rejected as allegedly anticipated by the Barker reference (US 5,947,967). Claim 22 is being amended to recite that the offsetting member is external to the recited body, whereas item 65 of Barker is on the inside of item 20. Claims 23, 24, and 26-33 are allowable due to their dependence on amended claim 22, and/or on their own merit. For example, item 65 of Barker is defined to be cylindrical, not ring-shaped as claim 23 recites. Claim 26 recites a groove in the offsetting member, and the Office Action does not identify such a groove in the Barker reference. In fact, it appears to recite exactly the opposite—an annular ridge 67 around the surface of item 65 (see Barker, column 9, lines 4-7). As to claim 33, no reference was made to any structure shown or text recited in Barker that suggests a clamp for a bone fixation member, as recited in claim 33. Without such disclosure, there cannot be anticipation.

Rejections under Section 103

The Office Action asserted that claims 1-3, 6-9 and 35-36 were obvious in view of U.S. Patent No. 5,562,661 to Yoshimi and the Brace reference noted above. Respectfully, even if the references can properly be combined, they do not show all features of claim 1.

For example, Yoshimi does not show a body that has a portion that tapers outwardly toward a second end. The Office Action only asserted the conclusion that such a feature was shown in Yoshimi, but did not indicate what part of the reference it might be. In fact, Yoshimi does not include an outwardly tapering portion at all. As another example, the Office Action considered item 50 of Yoshimi to be a washer as recited in claim 1, but item 50 does not have an inner surface with a diameter smaller than a diameter of a tapered portion of the body. Since the Office Action did not identify an outwardly tapered portion, and none exists in Yoshimi, there is no diameter to be compared with an inner surface of item 50.

Further, the curved underside of item 50 of Yoshimi appears to have a diameter that is at least

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as large as the curvature on the top of its item 14. That diameter does not appear to be smaller than any diameter found on item 14. Yoshimi also does not show an "offsetting member" as recited in claim 1. The Office Action asserts that nut 26 is such a member, but it does not offset anything, but merely holds items 12, 14 and 50 together. Moreover, as discussed above, nut 26 cannot be an "offsetting member" according to the claim because it is not slidable over an end of item 14. The threads of nut 26 prevent sliding with respect to item 12, and nut 26 is firmly held to item 50, and thus never slides over item 14 at all.

For these and likely other reasons, claim 1 is not obvious over the Yoshimi and Brace references. Claims 2-9 and 35 are dependent from claim 1, and are non-obvious for at least that reason and/or on their own merit. For example, claim 35 recites that a portion of the body extends through the offsetting member. No part of Yoshimi's item 14 extends through nut 26. Further, as to claim 5, the Office Action does not identify any "groove" in Yoshimi, Brace or U.S. Patent No. 6,210,413 to Justis that could correspond to the recited groove.

As to claim 25, it was rejected only as allegedly obvious over the Barker and Justis references. As discussed previously, Barker does not anticipate claim 22 as amended, and therefore not all elements of claim 25 are shown in these references.

Additional Remarks

Claims 36 and 38 are being cancelled without prejudice to reconsideration in this or a continuing application. No concession is being made concerning their patentability.

On review of allowed claim 10, it was noted that the term "spinal fastener" appeared in the claim, referring to the "bone fixation member" identified earlier in the claim. To forestall any future concern over antecedent basis, the amendments to claim 10 noted above are offered to conform the latter language to the prior usage. No change to the subject matter of claim 10 is intended or has been made, and no new matter has been added.

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Claims 16-17 and 19-20 have been amended to depend from allowable claim 39.

Similarly, claims 31-33 have been amended to depend from allowable claim 37. No substantive changes have been made to the language of those claims. These claims are allowable based on that dependence and/or on their own merit, as discussed above.

New claims 40-50 have been offered, and they depend from claims previously deemed allowable. Support for these claims is found throughout the text and drawings of the application, including the original claims, paragraphs 0017 and 0018 of the application and associated drawings. No new matter has been added, and no additional searching or analysis is believed necessary for allowance of these claims.

It should be understood that the above remarks are not intended to provide an exhaustive basis for patentability or concede the basis for the rejections in the Office Action but are simply provided to address the rejections made in the Office Action in the most expedient fashion. Applicants reserve the right to contest later positions taken in the Office Action that are not specifically addressed herein. None of the arguments made herein are intended to limit the literal or equivalent scope of the claims.

In conclusion, because the claims in this case are allowable over the references relied on in the pending Office Action for at least the above reasons, a Notice of Allowance in this case is respectfully solicited.

Respectfully submitted,



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